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Attorney Docket No. 5512.1

PATENT

JUN 20 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESIn re Application of:  
Spotnitz, et al

Group Art Unit: 3629

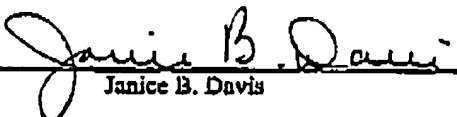
Serial No. 09/821,553

Examiner: I. Borissov

Filed: March 29, 2001

For: METHOD OF DOING BUSINESS: CUSTOMER-DRIVEN  
DESIGN OF A CHARGE STORAGE DEVICEVIA FACSIMILE  
703-872-9306  
Total Pages: 15REPLY BRIEF TO THE EXAMINER'S ANSWERMail Stop Appeal Brief-Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in reply to the Examiner's Answer  
mailed April 21, 2005.CERTIFICATE OF FACSIMILE TRANSMISSIONI hereby certify that this correspondence is being facsimile  
transmitted to the United States Patent and Trademark Office on  
June 21, 2005.  
\_\_\_\_\_  
Janice B. Davis

#### I. REAL PARTY IN INTEREST

Battery Design Co. is the real party in interest as the assignee of record in the instant application.

#### II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

#### III. STATUS OF THE CLAIMS

Claims 1-5 and 7-12 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,016,047 ("Notten") in view of the official notice taken by the Examiner, i.e. "it is well known fact that propriety information/parameters related to specifics of a software/models are kept confidential from customers." Furthermore, Claims 1-5 and 7-12 are the subject of this Appeal.

#### IV. STATUS OF AMENDMENTS

No Claim was amended after the Final Rejection and prior to this Appeal.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter defined in independent Claims 1, and 7.

According to Claim 1, the instant invention is a method for designing a charge storage device (CSD). (Specification, Page 7, Lines 23-24). The method includes the following steps:

providing more than one model of a charge storage device, the model adapted to convert at least one CSD customer inputted requirement selected from the group consisting of energy density, cycle life, rate capability, impedance, temperature range of operation and/or survival, safety requirements, storage life, self-discharge behavior, form factor, and cost into at least one CSD design (Specification, Page 8, Lines 1-3 and Page 16, Lines 1-5);

providing an interface, the interface being adapted to pass the CSD customer inputted requirement to the model, the interface being adapted to pass CSD design from the model, and the interface being adapted to hide the model (Specification, Page 8, Lines 4-8);

wherein the CSD customer addresses the interface with the CSD customer inputted requirement, the interface directs the CSD customer inputted requirement to at least one of the models, the model generates the CSD design that passes through the interface to the CSD customer (Specification, Page 8, Lines 8-11).

According to Claim 7, the instant invention is a method for designing a charge storage device (CSD). (Specification, Page 8, Lines 13-14). The method includes the following steps:

providing a CSD customer interface adapted for defining a CSD customer inputted test procedure for a desired charge storage device and defining a CSD customer inputted requirement for the charge storage device, the CSD customer inputted requirement being selected from the group consisting of energy density, cycle life, rate capability, impedance, temperature range of operation and/or survival, safety requirements, storage life, self-discharge behavior, form factor, and cost

(Specification, Page 8, Lines 14-18 and Page 16, Lines 1-5);

providing a plurality of charge storage device models (Specification, Page 8, Lines 18-19);

providing a routine capable of selecting at least one of the charge storage device models (Specification, Page 8, Lines 19-21);

executing a simulation wherein the CSD customer test procedure, the CSD customer requirement, and the selected charge storage device model are combined to render a custom charge storage device design and the models are hidden from the CSD customer (Specification, Page 8, Lines 21-24);

storing the custom charge storage device design (Specification, Page 8, Line 24); and

outputting the custom charge storage device design  
(Specification, Page 9, Lines 1-2).

**VI. GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,016,047 ("Notten") in view of the official notice taken by the Examiner, i.e. "it is well known fact that propriety information/parameters related to specifics of a software/models are kept confidential from customers."

Claims 7-12 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,016,047 ("Notten") in view of the official notice taken by the Examiner, i.e. "it is well known fact that propriety information/parameters related to specifics of a software/models are kept confidential from customers."

**VII. ARGUMENT**

The Applicant maintains the argument's set forth in his Reply Brief dated February 2, 2005. Furthermore, the Applicant contravenes the Examiner's Answer.

**A. CLAIMS 1-5 ARE NON-OBVIOUS UNDER 35 U.S.C. 103(a)**

Claims 1-5 are non-obvious under 35 U.S.C. 103(a) over U.S. Patent No. 6,016,047 ("Notten") in view of the official notice

taken by the Examiner, i.e. "it is well known fact that propriety information/parameters related to specifics of a software/models are kept confidential from customers," for the reasons stated below.

To reject claims in an application under section 103, an examiner must show a *prima facie* case of obviousness. In *re Dewel*, 51 F. 3d 1552, 1557, 34 U.S.P.Q.2D 1210, 1214 (Fed. Cir. 1995). Furthermore, all words in a claim must be considered in judging the patentability of that claim against prior art. In *re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). While the claims of a patent limit the invention, and specification cannot be utilized to expand the patent monopoly, it is fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention. *U.S. v. Adams*, 383 U.S. 39, 49(1966). To establish a *prima facie* case of obviousness, the following three basic elements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) the prior art reference or references when combined must teach or suggest all the claim limitations; and (3) there must be a reasonable expectation of success. MPEP

§ 2143. It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hill/Hydrocurve, Inc.* 796 F. 2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986). It is an error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a blueprint. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). In addition, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention that is being modified, then the teachings of references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Finally, if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F. 2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

With regard, to Examiner first argument in section 11.1 of the Examiner's Answer, the Examiner improperly takes portion of Notten out its context to support his argument. With regard to the temperature, the Examiner refers to Column 6, Lines 43-49 to support his argument; however, this portion of Notten discloses

a temperature calculated based on a temperature model. This is different than a customer inputted requirement. The Examiner further refers to Column 10, Lines 37-40 in an attempt to support his argument that there is an input from a user. Again, the Examiner improperly takes this portion of Notten out of its context to show a user input; however, the noted portion of Notten simply discloses that a user may input a battery type. There is no mention of a customer inputting a temperature range, but the Examiner improperly utilizes the instant invention as a blueprint, and takes the noted portions of Notten out their context to support his argument. Furthermore, the Examiner refers to different portions of Notten, i.e. producing a battery according to output characteristics, and then, the Examiner stipulates that this discloses all possible interpretations of the term "design output." However, the Examiner fails to recognize that Notten merely refers to producing a battery based on output characteristics, and nothing substantive is really disclosed with regard to a design output; furthermore, Notten fails to show any working examples, and Examiner fails to show that Notten does provide any working examples.

With regard to the Examiner's argument in section 11.4, the Examiner refers to Column 10, Lines 37-40 in an attempt to support his argument that there is a user input. Again, the



Examiner improperly takes this portion of Notten out of its context to show a user input; however, the noted portion of Notten simply discloses that a user may input a battery type. There is no mention of a customer inputting a temperature range; thus, the Examiner improperly utilizes the instant invention as a blueprint, and takes the noted portions of Notten out their context to support his argument. Furthermore, the Examiner argues that limitations from specification are not to be read into the claims. However, while the claims of a patent limit the invention, and specification cannot be utilized to expand the patent monopoly, it is fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention. *U.S. v. Adams*, 383 U.S. 39, 49(1966). Additionally, contrary to Examiner's assertion, the specification is not used to interpret Claim 1; in fact, extrinsic evidence, i.e. a dictionary, is used to shed light on the plain meaning of the term "customer." The term customer is defined as a person who buys goods and services, especially on regular basis. Contrary to the Examiner's argument, the definition of a customer does impart to Claim 1 the following functionality, i.e. a person who buys goods and services, especially on a regular basis. Thus, there is no need for it to be recited in Claim 1. The instant invention requires a customer, i.e. a person who buys goods or services, to input

an inputted requirement selected from the group consisting of energy density, cycle life, rate capability, impedance, temperature range of operation and/or survival, safety requirements, storage life, self-discharge behavior, form factor, and cost. Notten fails to mention all of the required features of the instant invention; furthermore, there is no motivation to modify the teachings of Notten.

Therefore, the instant invention according to Claim 1 is non-obvious. Furthermore, Claims 2-5 depend from Claim 1; thus, Claims 2-5 are non-obvious.

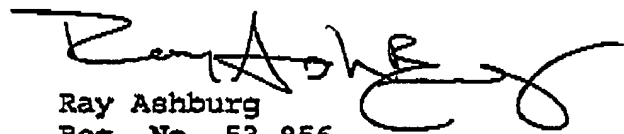
B. CLAIMS 7-12 ARE NON-OBVIOUS UNDER 35 U.S.C. 103(a)

Claims 7-12 are non-obvious under 35 U.S.C. 103(a) over U.S. Patent No. 6,016,047 ("Notten") in view of the official notice taken by the Examiner, i.e. "it is well known fact that propriety information/parameters related to specifics of a software/models are kept confidential from customers," for the reasons stated above with regard to Claims 1-5.

C. CONCLUSION

In view of the foregoing, Applicant respectfully requests an early Notice of Allowance in this application.

Respectfully submitted,



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### VIII. CLAIM APPENDIX

1. A method for charge storage device (CSD) customer driven charge storage device design comprising the steps of:

providing more than one model of a charge storage device, the model adapted to convert at least one CSD customer inputted requirement selected from the group consisting of energy density, cycle life, rate capability, impedance, temperature range of operation and/or survival, safety requirements, storage life, self-discharge behavior, form factor, and cost into at least one CSD design;

providing an interface, the interface being adapted to pass the CSD customer inputted requirement to the model, the interface being adapted to pass CSD design from the model, and the interface being adapted to hide the model;

wherein the CSD customer addresses the interface with the CSD customer inputted requirement, the interface directs the CSD customer inputted requirement to at least one of the models, the model generates the CSD design that passes through the interface to the CSD customer.

2. The method of claim 1 wherein the model is selected from the group consisting of first principles' models, empirically-based models, and hybrid models consisting of

combinations of first principles' models and empirically-based models.

3. The method of claim 1 wherein the CSD customer inputted requirement further comprised a plurality of CSD customer inputted requirements.

4. The method of claim 1 wherein the CSD design further comprises a plurality of CSD designs.

5. The method of claim 1 wherein the model further comprises a database, the model and the database being in communication.

6. (Cancelled).

7. A method for charge storage device (CSD) customer-driven charge storage device design comprising the steps of:  
providing a CSD customer interface adapted for defining a CSD customer inputted test procedure for a desired charge storage device and defining a CSD customer inputted requirement for the charge storage device, the CSD customer inputted requirement being selected from the group consisting of energy density, cycle life, rate capability, impedance,

temperature range of operation and/or survival, safety requirements, storage life, self-discharge behavior, form factor, and cost;

providing a plurality of charge storage device models;

providing a routine capable of selecting at least one of the charge storage device models;

executing a simulation wherein the CSD customer test procedure, the CSD customer requirement, and the selected charge storage device model are combined to render a custom charge storage device design and the models are hidden from the CSD customer;

storing the custom charge storage device design; and  
outputting the custom charge storage device design.

8. The method of claim 7 wherein the selecting routine being adapted for either CSD customer selection of routine selection based upon, at least in part, the CSD customer test procedure and the CSD customer requirement.

9. The method of claim 7 wherein the model further comprises a sizing program and a performance program.

10. The method of claim 7 wherein the model further comprises a sizing program, a performance program, and an abuse program.

11. The method of claim 7 wherein executing a simulation further comprises the step of optimizing the simulation.

12. The method of claim 7 wherein outputting the custom charge storage device design further comprises the step of reporting the design.

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